REMARKS

The rejection of Claim 2-14 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is respectfully traversed. While Claims 2-14 were rejected, only Claim 14 is mentioned as being indefinite. Claim 14 does not state or infer that the apparatus has a roulette ball which comes to rest on a numbered slot on a wheel. In particular, claim 14's paragraph (b) does not claim a roulette ball or a roulette wheel, it simply states that the set of winning numbers corresponds to numbered slots on a conventional roulette wheel, but it does not claim the wheel itself. The reference to roulette wheel and ball are only to indicate that the numbers of the set that are selected by the claimed selector correspond to those of conventional roulette wheel slots, not that the apparatus has a roulette wheel or ball. This is explained in the specification in several places. See, e.g., page 3, line 1, and page 5, lines 16-18. Defining the content of the set of numbers as corresponding to the slot numbers of a conventional roulette wheel does not mean that a conventional roulette wheel is an element of the claim. If claim 14 instead stated that the set of numbers corresponds to the months of a calendar year, one would not assume that the months of a calendar year are elements of the claim. For these reasons, the subject claims are not indefinite.

Moreover, claim 14 has been amended to remove extraneous text.

The rejection of claim 14 under 35 U.S.C. §102(b) as being anticipated by Orselli is respectfully traversed. Claim 14 has been amended. Claim 14 is patentably distinguishable from Orselli in that it specifically excludes a roulette wheel, whereas Orselli requires the use of a roulette wheel (120). Applicant's "selector" produces a "winning" number to be used in place of a ball dancing around a roulette wheel, whereas in Orselli the number generated by the random number generator is not necessarily the winning number. Orselli's winning number is determined by his roulette wheel (Orselli, column 5, lines 4-9). Likewise, Orselli's display is not for displaying the "selected" number, as used in the claim, but is for displaying a secondary number which is most often not the winning number - it can only be the winning number when it matches the "winning" number produced by Orselli's conventional roulette wheel and roulette ball, and the chances of such an

occurrence is only "once in 1444 plays" (Orselli, column 5, lines 14-19). For these reasons, Orselli does not anticipate Claim 14.

The rejection of claims 14, 7, 8, 10, and 11 under 35 U.S.C. §102(e) as being anticipated by Herman de Raedt (hereinafter the '126 patent) is respectfully traversed. Applicant's application is based on his U.S. Provisional Application No. 60/189,544, filed on March 15, 2000. The '126 patent was not filed until March 9, 2001. As such it is not 102(e) prior art and therefore does not anticipate applicant's invention.

Moreover, the '126 patent also includes a conventional roulette wheel for determining the winning number. Furthermore, the random number generator produces only bonus numbers which are outside the well known conventional rules of roulette whereas the subject claims are directed to games played generally according to conventional roulette rules. For both these reasons the '126 patent does not anticipate the subject claims.

The rejection of Claims 2 and 4 under 35 U.S.C. §103(a) as being unpatentable over Orselli in view of Salvucci is respectfully traversed.

Orselli already has one random number generator that "generates and displays one of the conventional roulettes numbers, i.e., 1-36, 0 or 00." (See Orselli Abstract, lines 9-11.) If an artisan in the pertinent art wanted to eliminate Orselli's roulette wheel to avoid statutory gaming restrictions (as was the problem addressed by applicant), the artisan would not be motivated to add a **second** random number generator, such as a ball selector. Why would the artisan be motivated to go to the added expense to add an expensive ball selector when Orselli already includes a random number generator that produces numbers corresponding to a roulette wheel? The fact is, there would be no motivation, and the prior art suggests no combination of **two random number generators** to replace a single roulette wheel.

Further, Orselli discloses no suggestion, teaching, or motivation for using a ball selection device to generate random numbers. Orselli already has a random number generator. Orselli actually teaches away from the use of replacing the roulette wheel because he already has a random number generator in his roulette game and, because of its marketing appeal, chose to keep the roulette wheel. It would not make any sense for Orselli to replace the roulette wheel with another random number

generator, not associated with roulette. Instead, Orselli chose to keep the roulette wheel and add a random number generator as a side attraction. Just because there is a ball selection device does not make Orselli obvious in view of Salvucci.

> The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Fritch* 28 USPQ2d 1781, 1783 (Fed.Cir. 1992)

Moreover. Orselli lacks a display for displaying the winning number. Replacing the roulette wheel in Orselli with the ball blower of Salvucci does not make applicant's invention obvious, since neither provide a display for the selected number.

There is no suggestion in Orselli for making the modification suggested by the examiner.

For all these reasons, Orselli in view of Salvucci does not make applicant's claims 2 and 4 obvious.

The rejection of Claim 3 under 35 U.S.C. §103(a) as being unpatentable over Orselli in view of Salvucci as applied to claim 2, and in further view of Ex Parte Breslow 192 USPQ 431, is respectfully traversed. The above discussion pertaining to Orselli in view of Salvucci is incorporated herein. Again, Orselli teaches away from replacing the roulette wheel with a ball blower or any other random number generator because he already has a random number generator.

The rejection of Claim 5 under 35 U.S.C. §103(a) as being unpatentable over Orselli in view of Salvucci as applied to Claim 2 above, and further in view of Santora is respectfully traversed. The above discussion pertaining to Orselli in view of Salvucci is incorporated herein. Again, Orselli teaches away from replacing the roulette wheel with a ball blower or any other random number generator because he already has a random number generator. Since it would not be obvious to add a ball selector to an already extant random number generator, it would not be obvious to include a camera to display a selected ball.

The rejection of Claim 6 under 35 U.S.C. §103(a) as being unpatentable over Orselli in view of Ex parte Breslow is respectfully traversed. The above discussion pertaining to Orselli in view of Salvucci is incorporated herein. Again, Orselli teaches away from replacing the roulette wheel with a ball blower or any other random number generator because he already has a random number

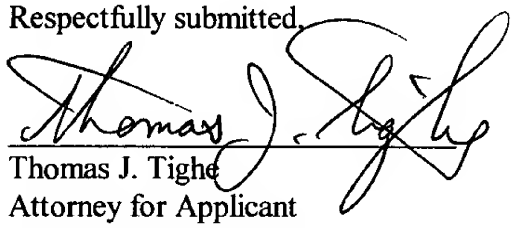
generator. There must still be some suggestion, motivation or teaching for making such a change and none exists in Orselli, nor in any other prior art, nor in the problem solved by applicant as discussed above.

The rejection of Claim 9 under 35 U.S.C. §103(a) as being unpatentable over Herman in view of official notice is respectfully traversed. Herman cannot be the basis for an "official notice" since it post dates applicant's subject invention.

The rejection of Claims 12 and 13 under 35 U.S.C. §103(a) as being unpatentable over Herman in view of Smith and further in view of official notice for a card shuffler is respectfully traversed. Herman is not prior art in view of applicant's U.S. Provisional Application No. 60/189,544, filed March 15. 2000. Thus, the rejection is invalid.

It is believed the application is now in a condition for allowance, and reconsideration of this application is earnestly solicited.

Respectfully submitted,



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